



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,480	06/20/2001	Tadao Yoshida	7217/64728	4411
7590	10/04/2004		EXAMINER	
COOPER & DUNHAM LLP 1185 Avenue of the Americas New York, NY 10036			THEIN, MARIA TERESA T	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/885,480	YOSHIDA ET AL. <i>31</i>	
	Examiner	Art Unit	
	Marissa Thein	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 June 2001.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
 4a) Of the above claim(s) 13-16, 28 and 29 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-12, 17-27 and 30-40 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 20 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Amendment

Applicant's "Preliminary Amendment" received on January 29, 2002 has been considered and entered.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 17-27, and 30-40, drawn to an information distribution system comprising a recording means and reproducing means for recording a content data onto a recording medium and reproducing the identifier unique to the recording medium and the prepaid information, classified in class 705, subclass 26.
- II. Claims 13-16, drawn to a terminal apparatus comprising receiving means for receiving a result of a balance inquiry and a prompting means for prompting, when the balance inquiry received by the receiving indicates a shortage of amount of money for the received content data, classified in class 705, subclass 26.
- III. Claims 28-29, drawn to a recording medium comprising an unrewritable area, a recording area, and a managing area, classified in class 360, subclass 55.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a terminal apparatus comprising receiving means for receiving a result of a balance inquiry and a prompting means for prompting, when the balance inquiry received by the receiving indicates a shortage of amount of money for the received content data. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a recording medium comprising an unrewritable area, a recording area. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, restriction for examination purposes as indicated is proper.

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility

Art Unit: 3625

such as a recording medium comprising an unrewritable area, a recording area. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Jay Maioli on September 14, 2004 a provisional election was made without traverse to prosecute the invention of I, claims 1-12, 17-27, and 30-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-16 and 28-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

The drawings filed on April 20, 2001 are acceptable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 1, 11-12, 17, 26-27, 30, and 39-40 are rejected under 35 U.S.C. 102(e)
as being anticipated by U.S. Patent No. 6,018,720 to Fujimoto.**

Regarding claim 1, Fujimoto discloses an information distribution system having a terminal apparatus in which a recording medium has recorded thereon an identifier unique to the recording medium and prepaid information and is loadable in an information center that is connectable to the terminal apparatus and transmits content data thereto via a predetermined communication line (see at least Figure 1; Figure 2; col. 2, lines 46-65), the terminal apparatus comprising:

- first receiving means for receiving the content data transmitted from the information center (see at least col. 2, lines 46-65; col. 3, lines 1-4; col. 8, lines 61-66);
- recording and reproducing means for recording the content data received by the first receiving means onto the recording medium loaded in the terminal apparatus and reproducing the identifier unique to the recording medium and the prepaid information (see at least col. 2, lines 46-65; col. 3, lines 1-35; col. 9, lines 40-55);
- first transmitting means for transmitting the reproduced identifier unique to the recording medium and the reproduced prepaid information to the information center (see at least col. 3, lines 1-35; col. 9, lines 40-64; col. 6, lines 41-58);
- the information center comprising:
- first storage means for storing a plurality of content data (see at least col. 8, lines 16-24; Figure 1; col. 6, lines 22-23);

- second transmitting means for transmitting predetermined content data from the first storage means to the terminal apparatus (see at least col. 6, lines 23-38);
- second receiving means for receiving the identifier unique to the recording medium and the prepaid information transmitted from the terminal apparatus (see at least col. 6, lines 23-58; col. 13, line 63 – col. 14, line 5);
- second storage means for storing a usable remaining amount of money relative to the prepaid information in accordance with the identifier unique to the recording medium and the prepaid information received by the second receiving means (see at least col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5); and
- charging processing means for updating, when the predetermined content data are transmitted from the first storage means to the terminal apparatus, the usable remaining amount of money stored in the second storage means for a charge of the predetermined content data transmitted from the first storage means to the terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5).

Regarding claims 11-12, Fujimoto discloses wherein the identifier unique to the recording medium and the prepaid information are recorded on the recording medium so as to be unrewritable (see at least col. 3, lines 11-14; col. 3, lines 24-30); and wherein communication destination identifying information for connecting the terminal apparatus to the information center is also recorded on the recording medium (see at least col. 3, lines 46-51; col. 13, lines 4-18).

Regarding claims 17, Fujimoto discloses an information center, connected to a terminal apparatus via a predetermined communication line, for distributing content data, comprising:

- first storage means for storing a plurality of content data (see at least col. 6, lines 22-25);
- transmitting means for transmitting predetermined content data from said first storage means to said terminal apparatus (see at least col. 3, lines 24-36; col. 8, lines 16-24; col. 16, lines 9-19);
- receiving means for receiving an identifier unique to a recording medium and prepaid information stored therein transmitted from said terminal apparatus (see at least col. 3, lines 24-36; col. 8, lines 16-24; col. 16, lines 9-19);
- second storage means for storing a usable remaining amount of money in accordance with said identifier unique to said recording medium and said prepaid information received by said receiving means (see at least col. 3, lines 4-23; col. 8, line 57 – col. 9, line 5; col. 9, lines 21-29);
- charging processing means for updating, when said predetermined content data are transmitted from said first storage means to said terminal apparatus, said usable remaining amount of money stored in said second storage means for a charge of said predetermined content data transmitted from said first storage means to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5).

Regarding claims 26-27, the claims recite an information center connected to a terminal apparatus that is parallel in scope to claims 11-12 above and are rejected under similar grounds.

Regarding claim 30, Fujimoto discloses information distribution method for distributing content data from an information center to a terminal apparatus in which a recording medium is loadable and recording the distributed content data thereto, said information center and said terminal apparatus being interconnected via a predetermined communication line, comprising the steps of:

- receiving an identifier unique to said recording medium and prepaid information recorded on said recording medium transmitted from said terminal apparatus (see at least col. 6, lines 23-58; col. 13, line 63 – col. 14, line 5);
- storing, in a memory, a usable remaining amount of money relative to the prepaid information in accordance with said received identifier unique to said recording medium and said received prepaid information (see at least col. 3, lines 4-23; col. 8, line 57 – col. 9, line 5; col. 9, lines 21-29);
- comparing said usable remaining amount of money stored in said memory with a charge of content data to be distributed from said information center to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5);
- permitting, when said usable remaining amount of money stored in said memory is greater than said charge of said content data to be distributed from said information center to said terminal apparatus, the transmission of said content

data from said information center to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5); and

- updating, by said charge of said content data, said usable remaining amount of money stored in a second memory when said content data are transmitted from said information center to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5).

Regarding claims 39-40, the claims recite a method that is parallel in scope to claims 4-10 above and are rejected under similar grounds.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-3, 18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,018,720 to Fujimoto in view of U.S. Patent No. 6,144,745 to Akiyama et al.

Regarding claim 2, Fujimoto substantially discloses the claimed invention, however, it does not disclose the recording medium also records information about a remaining recordable capacity thereof, the information is reproduced by the recording

and reproducing means, the reproduced information is transmitted by the first transmitting means to the information center. Fujimoto discloses the purchaser may increase the number of game software recorded therein within storage or memory capacity thereof (col. 9, lines 12-15). Furthermore, Fujimoto discloses blocks of data purchased by the purchaser (see at least col. 10, lines 19-21). Akiyama, on the other hand, teaches the recording medium also records information about a remaining recordable capacity (see at least col. 6, lines 57-64).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Fujimoto, to includes the recording of the remaining recording capacity, as taught by Akiyama, so as to be notified as to whether there is left a capacity enough to store the data (Akiyama col. 6, lines 60-61).

Regarding claim 3, Fujimoto substantially discloses the claimed invention, specifically, the first comparing means for comparing usable remaining amount of money stored in the second storage means with a price of content data to be transmitted to the terminal apparatus (see at least col. 8, line 66- col. 9, line 3; col. 9, lines 56-64). However, Fujimoto does not disclose the second comparing means for comparing the information about a remaining recordable capacity of the recording medium with a size of the content data to be transmitted to the terminal apparatus. Fujimoto discloses the purchaser may increase the number of game software recorded therein within storage or memory capacity thereof (col. 9, lines 12-15). Akiyama, on the other hand, teaches the second comparing means for comparing the information about

a remaining recordable capacity of the recording medium with a size of the content data to be transmitted to the terminal apparatus (see at least col. 6, lines 57-64).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Fujimoto, to includes the recording of the remaining recording capacity, as taught by Akiyama, so as to be notified as to whether there is left a capacity enough to store the data (Akiyama col. 6, lines 60-61).

Regarding claim 18, the claim recites an information center connected to a terminal apparatus that is parallel in scope to claim 3 above and is rejected under similar grounds.

Regarding claim 31, the claim recites a method that is parallel in scope to claim 3 above and is rejected under similar grounds.

Claim 4-10, 19-25 and 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,018,720 to Fujimoto and U.S. Patent No. 6,144,745 to Akiyama et al. and further in view of U.S. Patent No. 6,539,468 to Inoue et al.

Regarding claims 4-10, the combination of Fujimoto and Akiyama substantially disclose the claimed invention, however, it does not disclose the prompt for the loading of a second recording medium recording; adding means for adding; the edition based on the information about the remaining recordable capacity of the previously loaded recording medium and the information about the remaining recordable capacity of the second recording medium; when the remaining recordable capacity is found by the

second comparing means to be smaller than the size of content data to be transmitted to the terminal apparatus, a control signal is transmitted from the information center to the terminal apparatus to instruct; the terminal apparatus to prompt for the loading of a second recording medium recording the remaining recordable capacity of the second recording medium is compared with the size of the content data to be transmitted to the terminal apparatus; and, contents recorded on the second storage means are updated. The combination discloses the purchaser may increase the number of game software recorded therein within storage or memory capacity thereof (Fujimoto col. 9, lines 12-15). Furthermore, the combination discloses the remaining recordable capacity (Akiyama see at least col. 6, lines 57-64),

Inoue, on the other hand, teaches the prompt for the loading of a second recording medium recording; adding means for adding; the edition based on the information about the remaining recordable capacity of the previously loaded recording medium and the information about the remaining recordable capacity of the second recording medium; and, contents recorded on the second storage means are updated (see at least col. 1, lines 38-57; col. 2, lines 16-34).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the prompting, adding, editing, and the updating, as taught by Inoue, in order to providing copying control information recorded on a first recording medium onto a second recording medium (Inoue col. 1, lines 38-45).

Regarding claims 19-25, the claims recite an information center connected to a terminal apparatus that is parallel in scope to claims 4-10 above and are rejected under similar grounds.

Regarding claims 32-38, the claims recite a method that is parallel in scope to claims 4-10 above and are rejected under similar grounds.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,576,840 to Fukushima discloses a method for displaying the remaining recordable capacity of a recording medium.

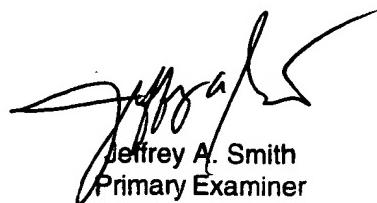
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 29, 2004
mtot



A handwritten signature in black ink, appearing to read "Jeffrey A. Smith".

Jeffrey A. Smith
Primary Examiner